REMARKS

I. Introduction

Claims 1-27 are pending in the above application.

Claims 1, 7-9, 11, 14-17, 19-21 and 23-27 stand rejected under 35 U.S.C. § 102.

Claims 2-5, 12, 18 and 22 stand rejected under 35 U.S.C. § 103.

Claims 1, 9, 20, 21, 24, 25 and 27 are independent claims.

II. Prior Art Rejections

A. Claims 1, 7-9, 11, 14-17, 19-21 and 23-27 stand rejected under 35 U.S.C. § 102 as being anticipated by Lin et al. (U.S. Pat. 6,603,849).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

While it was believed that the Examiner agreed that the above claims are patentable over Lin, during a teleconference on June 22, 2006 after which Applicant submitted terminal disclaimers as requested by the Examiner, it appears that the Examiner has changed his mind.

As discussed in previous responses, Lin does not disclose or suggest a method of seamlessly transferring an ongoing communication session between a first device and a correspondent device on an IP network to another device via a session specific IP address. Lin merely discloses to forward a telephone call from one network element to another network element when the called element does not answer the call. See, col. 3: 25 through col. 4: 44; and

col. 5: 13-25. More particularly, Lin discloses to have a user provide alternate numbers to a gatekeeper element 180 which then connects a call intended for a user to the alternate element when the user's device does not answer the call. See, Fig. 6; col. 5: 43 through col. 6: 12. The alternative numbers referred to in Lin are concerned with the various network elements required to complete a call to MS 20 or another endpoint, Lin is not concerned with transferring an ongoing communication session from one device to another user device. See, col. 4: 45 through col. 6: 12. Lin clearly is focused on setting up the call, i.e. completing a call. All transfers discussed in Lin are prior to creating a communication session. Lin states "in response to initiating a ringing tone on the H.323 endpoint 120, **if the H.323 subscriber does not answer the call (step 615)**, the H.323 endpoint 120 transmits the Release Complete message 140 with the re-routing cause 145 back to the Gatekeeper 180 (step 620)." Col. 5: 54-58.

In short, Lin does not disclose to use a "first device which uses a session specific IP address", as recited by claim 1 or a "an IP address" generated "specifically for initiating the communication session between the correspondent device and the first device" as recited by claim 9, and as substantially recited by claims 20, 21, 24, 25 and 27. While the Examiner appears to point to element 180 of Lin, (gatekeeper 180), there is no suggestion in Lin that element 180 uses a session specific IP address, or that the IP address of element 180 is anything other than a conventional fixed IP address. In fact, Lin does not appear to discuss an IP address of element 180 at all or even that element 180 actually has an IP address. Further, the IP address of element 180 is not used for a communication between users, the IP addresses of the users (i.e. address 187 and 189) is used for the communications. See, col. 3: 8-15.

Lin also does not disclose a first device which is "configured to allow a user to receive or send the communication session therefrom" as recited by claims 1 and 9, and as substantially

recited by claims 20, 21, 24, 25 and 27. The Examiner points to gatekeeper 180 as corresponding to Applicant's claimed first device. However, gatekeeper 180 is quite clearly an intermediate network element which only serves to set up communications to H.323 devices 120 and 125 from other devices. See, Lin, Figs. 1-5. Gatekeeper 180 is not a device through which a user receives or sends communications as recited by the claims.

Lin also does not disclose "transferring the first device IP address from the first device to the second device" as recited by claims 1 and 9, and as substantially recited by claims 20, 21, 24, 25 and 27. Again, the alleged "first device" in Lin, gatekeeper 180, does not transfer its IP address to another device. The discussion in column 3, lines 8-15 discuss using the IP address of the called device (aka endpoint 120) for the communication, not an IP address associated with element 180. The Examiner's reliance on column 4, line 64 to column 5, line 35 is misplaced. Lin clearly states to use "another IP address" when re-routing a call. See, col. 5: 21-26 "it should be understood that the alternative number 189 can be **another IP address** ...", and col. 5: 62-65 "this alternative number 189 could be **another IP address** for another H.323 endpoint ..." (bold added for emphasis). Indeed, it is not clear if the IP address of element 180 (assuming it has one) is ever used in a communication at all, rather it appears that the IP addresses of the endpoints 120 or 125 is used and element 180 is simply an intermediate element which sets up the calls. Notably, in the 102 rejection, the Examiner alleges that an IP address of element 180 is "transferred" to another device, but in rejecting claim 5 under 35 U.S.C. § 103, the Examiner alleges that the call is re-routed to an alternate IP address. Office action, mailed 7/14/06, pg. 10.

Furthermore, Lin does not disclose or suggest using a "Proxy ARP message" as recited in claim 20.

Lin also does not disclose or suggest notifying an agent that a communication session is being transferred as recited by claim 27. At best, it appears that the Office action is interpreting gatekeeper 180 as being both the "first node" and the "Agent" recited in claim 27. See, Office action, pgs. 8-9. Such double inclusion of an element clearly demonstrates a lack of anticipation.

Accordingly, as Lin does not disclose each and every element of any of independent claims 1, 9, 20, 21, 24, 25 or 27, Lin does not anticipate any of these claims. Likewise, since claims 6-8 depend on claim 1 and incorporate all of the limitations thereof; claims 11, 14-17 and 19 depend on claim 9 and incorporates all of the limitations thereof; and claim 23 depends on claim 21 and incorporates all of the limitations thereof; Lin does not anticipate these claims as well. Hence, Applicant respectfully requests the rejection to be withdrawn.

B. Claims 5 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lin alone.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Claim 5 was previously indicated to be allowable over the Lin reference, but the Examiner apparently changed his mind and now rejects claim 5 over the same Lin reference.

The Examiner now appears to conclude that it would have been obvious to modify the Lin reference to stop a re-routing of a call, which Lin discloses to re-routed because the first device did not answer, and return the call signaling (which the Examiner interprets as a "communication session" and the only kind of "communication" disclosed in Lin) to the first device which did not answer "so that the communication on the first device (sic) can resume to receive incoming communication." Office action, mailed 7/14/06, pg. 10. The rejection is clearly based on impermissible hindsight, and the motivation is based on nothing more than imaginary conjecture. Under the logic of the rejection, signaling for an unanswered call would be continuously bounced back and forth between the two devices until one of them was eventually, if ever, answered. The rejection is clearly improper and clearly devoid of any analysis under the *Graham v. Deere* tests.

As to claim 10, Lin does not disclose or suggest to request initiation of a session between the first device and the correspondent device and allow the first device to participate in additional communication sessions, as claimed in claim 10. Lin is concerned with a call completion with a single device (e.g. MS 20) in different network or setting up a call with an alternative device if the first device does not answer, i.e. call set up (see, Fig. 4, the last step is "connect call"), there is no discussion of transferring an active communication session to another device and then back to the first device.

Accordingly, as Lin neither discloses nor suggests all of the limitations of claim 5 or 10, Lin does not render either claim 5 or claim 10 unpatentable.

C. Claims 2-4, 6, 12, 18 and 22 stand rejected under 35 U.S.C. § 102 as being unpatentable over Lin in view of Johnston (U.S. Pat. 6,373,946).

Neither Lin nor Johnston, taken alone or in combination disclose or suggest all of the limitations of claims 2-4, 6, 12, 18, or 22, which depend on and incorporate the limitations of claims 1, 9 or 21, respectively. Lin does not disclose the limitations of either claims 1, 9 or 21 as discussed above. Johnston also does not disclose such, and the Office action does not rely on Johnston as disclosing such.

Accordingly, as neither Lin nor Johnston, taken alone or in combination do not disclose or suggest all of the claimed limitations of claims 2-4, 6, 12, 18 or 22, the combination of Lin and Johnston does not render these claims unpatentable.

III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Respectfully submitted,

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